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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,418	07/26/2000	Eric C. Anderson	P206/1847P	8121

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EXAMINER

TRAN, NHAN T

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/626,418	<b>Applicant(s)</b> ANDERSON ET AL.	
	<b>Examiner</b> Nhan T. Tran	<b>Art Unit</b> 2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 12 and 23 is/are rejected.
- 7) ☒ Claim(s) 2-7, 9-11, 13-18 and 20-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see amendment after final, filed 9/17/2004, with respect to claims 1-7, 9-18, 20-23. The rejections of claims 1-7, 9-18 and 20-22 under Safai (US 6,167,469), Wasula (US 2002/0054224) and Steinberg (US 6,006,039) have been fully considered and are persuasive. Therefore, the rejections are withdrawn. However, upon further consideration, a new ground of rejection is made in view of Sarbadhikari et al (US 5,477,264) for claims 1 & 12.

Regarding claim 23, a new ground of rejection is made in view of Safai (US 6,167,469). Since the Examiner has not addressed the Applicant's arguments filed 2/13/2004 for the previously added claim 23, the Examiner respectfully addresses those arguments in this Office Action. The Applicant asserts that Safai fails to teach or suggest the limitations "...including any combination of specifying a storage location, sending the images to one or more email addresses, and analyzing or performing calculations on the images..." (page 14 of Remarks filed 2/13/2004). In response, the Examiner respectfully disagrees with the Applicant. As disclosed in col. 15, lines 27-58 and col. 13, lines 10-25 and col. 14, lines 30-42, it is clearly seen that the server 601 provides not only e-mail service with attached images or specifying a storage area 614, but also provides other services, such as printing the images on T-shirts, coffee mugs, etc (this equates as analyzing or performing calculations on the images). Therefore, Safai meets the limitations of claim 23.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 & 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarbadhikari et al (US 5,477,264).

Regarding claim 12, Sabarhikari discloses a system for allowing a user to select actions (attaching frames/overlays as shown in Figs. 8 & 9) to be taken by a server (computer 4, Fig. 11) when uploading images from a hand-held image capture device (see col. 11, lines 5-9), the system comprising the steps of:

means for downloading (via cable 38, Fig. 11) an action list (frames/overlays, Figs. 8 & 9) from the server to the image capture device after the image capture device establishes a connection with the server, the action list including at least one item (frames/overlays) representing action that the server should take with respect to uploaded images (col. 10, line 54 – col. 11, line 9),

means for displaying the action list to the user on the image capture device after the user initiates an image upload process (Figs. 8 & 9, wherein the frames/overlays are displayed after an enhancement file is sent from the computer 4 to update the firmware 36 in Fig. 11);

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means for sending the images and the selected action list item from the image capture device to the server after the user selects at least one of the items in the action list, and means for performing the action on the uploaded images specified by the selected action item (see col. 11, lines 5-9).

Regarding claim 1, see the analysis of claim 12.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 23 is rejected under 35 U.S.C. 102(e) as being anticipated by Safai (US 6,167,469).

Regarding claim 23, Safai discloses a method for allowing a user to select actions to be taken by a server when uploading images from a hand-held image capture device, the method comprising:

storing an action list (Figs. 3 & 4 and note that each action is stored in the camera's memory to be executed by the CPU 210, Fig. 2) on the image capture device, the action list

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including one or more items representing actions that the server should take with respect to uploaded images, including any combination of specifying a storage location, sending the images to at least one e-mail address (Fig. 4E & F; col. 8, lines 48-67), and analyzing or performing calculations (i.e., for printing at server printer) on the images (see col. 15, lines 27-58);

displaying the action list to the user on the image capture device after the user initiates an image upload process (see Fig. 4A, wherein the action list is displayed after the user initiates uploading images by executing application 230; col. 8, lines 18-20);

after the user selects at least one of the items in the action list, sending the images and the selected action list item from the image capture device to the server (col. 13, lines 10-25); and

performing the action on the uploaded images specified by the selected action item (col. 13, lines 20-25; col. 14, lines 30-40 and col. 15, lines 28-58).

***Allowable Subject Matter***

4. Claims 2-7, 9-11, 13-18 & 20-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 2, 9-11, 13, 21-22, the prior art of record simply fails to be combined for teaching of each limitation of those claims in combination with their corresponding independent claims.

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Regarding claims 3-7, the claims are dependent of claim 2.

Regarding claims 14-18, the claims are dependent of claim 12.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhan T. Tran whose telephone number is (703) 605-4246. The examiner can normally be reached on Monday - Thursday, 8:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew B Christensen can be reached on (703) 308-9644. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NT.



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